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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,589	12/01/2000	Erik Krimm	225/49427	1848

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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/726,589

Applicant(s)

KRIMM ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 9 and 32 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 04 April 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Election/Restrictions***

Applicant's election with traverse of claims 9-32 in Paper No. 7 is acknowledged.

Regarding inventions I and II, the traversal is on the ground(s) that inventions I can not be made by plastic injection molding. This is not found persuasive because the stamped parts can be made by injection-molded parts, another and materially different process.

Regarding inventions I and III, the traversal is on the ground that the Office's reason for distinctness in the mutually exclusive species is seen as improper because invention I is "in the form of a gate plate" and III is a "gate plate". This is not found persuasive because applicant has not traverse on the grounds that the species are not patentably distinct by submitting evidence, identifying such evidence now of record showing the species to be obvious variants, or clearly admit on the record that this is the case.

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Regarding inventions I and IV, the traversal is on the ground that invention I relates to a functional component and invention IV relates to a method of making a gate plate. This is not persuasive since invention IV is not a method of making the functional component. If the method were so, then the apparatus and the method will be related.

Regarding claim II and III, the traversal is on the ground that invention II is a method of making a functional component while invention III is directed to a gate plate and therefore distinctness is improper. This is not found persuasive since a relationship does not exist. When an invention is a method of producing or making a gate plate and the apparatus is the gate plate, then a relationship exists.

Regarding claims III and IV, the traversal is on the ground that the gate plate can not be made by injection molding. This is not found persuasive because a different and materially different process can make the gate plate. The gate plate can be made using injection molding parts, a different and materially different process.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 9-32 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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Claims 9-32 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stamped parts being riveted (claim 3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 1, the limitation "a functional component as a gate plate" in line 1 is unclear. Since the gate plate has not been structurally defined, it unclear what features of the gate plate correspond to the functional component. Furthermore, the limitation "having engagement holes" in line 2 is unclear. Does the functional component, the gate plate, or the locking plate have the engagement holes?

Claim 5 recites the limitations "the injection-moulded plastic" in line 2, the injection-moulding compound". There is insufficient antecedent basis for these limitations in the claim.

Claim 7 recites the limitation "the plugged-in position" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the injection-moulding plastic" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 2-4 and 6, the claims depend from claim 1 and therefore become indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(d) as being barred by applicant's foreign patent DE-19,832,868 A1, (see translated document, US 6,182,527 B1).

Applicant is reminded that the foreign application was filed on 07/22/1998, which the foreign application is more than 12 months before the effective U.S. filing date, 12/01/99; the foreign application was filed by the same applicant as in the United States or by his or her legal representatives or assigns; the foreign patent was actually granted before the U.S. filing date; and, the same invention is involved.

Regarding claim 1, the German patent '868 discloses in Figures 1, 3 and 4 a plate functional component comprising at least three stamped parts **11, 12, 13**. One of the stamped parts **11, 12, 13** is a middle stamped part **11**. The stamped parts **11, 12, 13** lie flat against one another. The stamped parts **11, 12, 13** are unreleasably connected to one another and each of the stamped parts **11, 12, 13** have at least two engagement holes **2, 7**. The engagement holes **2, 7** are arranged congruently with respect to one another. At least one of the engagement holes **2, 7** in the middle stamped part **11**, has a hole wall **16** provided with an elastomeric plastic cover **24**.

Regarding claim 2, Figure 4 discloses the elastomeric plastic cover **24** is formed from plastic borders **18, 25**. The plastic borders **18, 25** are secured in undercuts **26** or cutouts of the middle stamped part **11** and surround a hole edge **A**.

Regarding claim 3, the German discloses the stamped parts **11-13** are riveted, soldered or welded together. Figure 3 shows the parts **11-13** riveted.

Regarding claim 4, the plastic cover **24** is around a hole edge **A**. Applicant is reminded that the method of forming the plastic cover by injection-moulding plastic is not germane to the issue of patentability of the functional component itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the German patent DE-19,832,868 A1.



Regarding claim 8, the German patent '868 discloses two of the stamped parts **11, 12, 13** are outer stamped parts **12, 13** and the functional component further comprises spacer lugs **A2** (see marked-up attachment). However, the German patent fails to disclose the spacer lugs **22** formed from a material that is harder than the outer stamped parts **12, 13**. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select plastic for the stamped parts and metal, a harder material, for the spacer lugs. *In re Leshin*, 125 USPQ 416.

### ***Allowable Subject Matter***

Claims 5-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 5, the prior art of record does not disclose or suggest a functional component comprising connecting webs leading from the plastic cover; and,

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regarding claims 6 and 7, these claims depend from claim 5.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4 and 8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



**Lynne H. Browne**  
**Supervisory Patent Examiner**  
**Technology Center 3600**

E.G.

June 11, 2002

Attachment: one marked-up page of German patent DE-19,832,868 A1.

